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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wachovia Corporation

Serial No. 78371570

Susan S. Jackson and Karl S. Sawyer, Jr. of Kennedy
Covington Lobdell & Hickman, LLP for Wachovia
Corporation.

Sung In, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Bucher, Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Wachovia Corporation seeks registration on the
Principal Register of the mark **CUSTOMCHOICE** (*in standard
character format*) for services recited in the application, as
amended, as follows:

"Investment brokerage services, namely, fee-
based nondiscretionary mutual fund services
for customers with a minimum account size of
\$25,000" in International Class 36.¹

¹ Application Serial No. 78371570 was filed on February 20,
2004 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the recited services, so resembles the mark **CUSTOM CHOICE** (*in standard character format*), which is registered for "life insurance, annuity, disability, long term care, supplemental health, homeowner's and auto insurance underwriting services; financial and retirement planning services; investment counseling services; and automobile warranty service contract services"² also in International Class 36, as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney submitted briefs, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the cited mark is not particularly distinctive in the insurance and financial services class; that its services and registrant's services

² Registration No. 2622601 issued to GE Financial Assurance Holdings, Inc., on September 24, 2002, claiming first use anywhere and first use in commerce at least as early as December 30, 1998. As of May 24, 2004, this registration was assigned to Genworth Financial, Inc., according to the Assignment Branch of the United States Patent and Trademark Office, at Reel 2936, Frame 0762.

are sufficiently distinct to avoid a likelihood of confusion; and that applicant's services, as recited, are directed exclusively to sophisticated consumers.

By contrast, the Trademark Examining Attorney argues that the evidence in this record demonstrates that applicant's mutual fund services are actually encompassed by registrant's "financial and retirement planning services" and "investment counseling services"; that the same financial institutions and entities that provide the balance of the cited services often provide applicant's recited services; that these respective services move in the same channels of trade and are often provided to the same classes of consumers; that applicant has not shown the cited mark to be weak in this field; and that even sophisticated consumers are not immune from source confusion when two marks are substantially identical.

Analysis: Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the

similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks

We turn first to the du Pont factor focusing on the similarity of the marks in their entireties. We must consider whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The marks are identical except for the fact that registrant's mark includes a space [**CUSTOM CHOICE**] while applicant's mark is spelled as one word [**CUSTOMCHOICE**]. The absence of the space does not significantly change the appearance of the marks. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ["There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"]; and In re Best Western Family Steak House, Inc., 222 USPQ 827, 827 (TTAB 1984) ["There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"]. In

addition to the fact that the marks would be pronounced identically, their connotations and commercial impressions would be virtually the same. The near-identical nature of the marks is a significant factor in the likelihood of confusion analysis. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ["Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant"]. In fact, applicant does not contest the fact that this du Pont factor favors the position of the Trademark Examining Attorney.

The number and nature of similar marks

As to the du Pont factor focusing on the number and nature of similar marks in use on similar services, applicant argues as follows:

Applicant submits that the cited registration is a very weak mark in the insurance and financial services class and is therefore only entitled to a narrow scope of protection, which even further reduces any potential for confusion. Applicant relies upon its survey of the Trademark Electronic Search System (TESS) which revealed that there are 71 registered marks containing the word CUSTOM in the insurance and financial services class. In addition, there are 365 registered marks containing the word CHOICE in the insurance and financial services class. Third party registrations are

probative to determine a common, weak significance of a part of a composite mark. Such registrations also go to show that the PTO by registering several marks with such a common segment makes confusion unlikely. *McCarthy On Trademarks And Unfair Competition*, 4th ed. Vol. 2, § 11:90 (2002).

However, we agree with the Trademark Examining Attorney who contends applicant's argument that the cited mark is weak for insurance and financial services is unpersuasive. Seventy-one registered marks having the word CUSTOM and 365 registered marks containing the word CHOICE in International Class 36 is unpersuasive in demonstrating that the combined term is weak when used in connection with insurance and financial services. The Trademark Examining Attorney concludes that "[a]pplicant's attempt to parse out the terms and count the recurrences of each in registered marks amounts to an improper dissection of the mark, which conflicts with the principle of comparing the overall impression of the marks." According to this record, we have to assume that the only mark in the insurance and financial services field having this combination is the cited mark.

The services

Accordingly, we turn to the du Pont factor focusing on the relationship of the services as recited in the application and cited registration. "In order to find that

there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989).

Moreover, we note that because the marks herein are strikingly similar, the relationship between the respective services on which registrant and applicant will be using their marks need not be as close as in the situation where the marks are not substantially identical. Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., supra at 1689 ["[E]ven when [the] goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source"].

In this case, the Trademark Examining Attorney argues that we should deem registrant's "financial and retirement planning services" and "investment counseling services" to encompass "mutual fund services" as proposed by applicant.

Further, even if we concluded that applicant's services may not overlap with registrant's services, the Trademark Examining Attorney contended that the record demonstrates that it is common for businesses providing insurance services to also provide financial and investment-related services. The Trademark Examining Attorney argues that this conclusion can be based in part upon the following third-party registrations placed into the record:

LEVERAGE YOUR RELATIONSHIP ³

and

EXTRACO PLUS PROGRAM ⁴



for inter alia " ... **financial planning, ... insurance underwriting in the fields of health, fire, life, casualty, property, home, and flood; investment brokerage; investment analysis and consultation ...** " in International Class 36;

for inter alia " ... **financial planning ... insurance underwriting in the fields of health, fire, life, casualty, property, home and flood; investment brokerage ...** " in International Class 36;⁵

³ Registration No. 2826380 issued to Extraco Corporation, a Texas corporation, on March 23, 2004, claiming first use anywhere and first use in commerce at least as early as December 15, 2003.

⁴ Registration No. 2874851 issued to Extraco Corporation, a Texas corporation, on August 17, 2004, claiming first use anywhere and first use in commerce at least as early as March 18, 2001.

⁵ Registration No. 2858833 issued to Extraco Corporation, a Texas corporation, on June 29, 2004, claiming first use anywhere and first use in commerce at least as early as January 2, 2002; the mark consists of the stylized word EXTRACO and the image of a bird in flight.



First National Trust Company

for inter alia " ... mutual funds investment ... investment brokerage ... investment consultation ... insurance services, namely insurance underwriting and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services ... " in International Class 36;⁶



F.N.B. Wealth Management

for inter alia " ... mutual funds investment ... investment brokerage ... insurance services, namely insurance underwriting, brokerage and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services ..." in International Class 36;⁷

F.N.B. WEALTH MANAGEMENT

for inter alia " ... mutual funds investment ... investment brokerage ... insurance services, namely insurance underwriting, brokerage and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services ... " in International Class 36;⁸

⁶ Reg. No. 2874225 issued to F.N.B. Corporation on August 17, 2004, claiming first use anywhere and first use in commerce at least as early as May 6, 2002; no claim is made as to the words NATIONAL TRUST COMPANY apart from the mark as shown; Section 2(f) claimed as to the word FIRST.

⁷ Registration No. 2864928 issued to F.N.B. Corporation on July 20, 2004 claiming first use anywhere and first use in commerce at least as early as January 2003; Section 2(f) in part as to F.N.B. WEALTH MANAGEMENT; no claim is made to the words WEALTH MANAGEMENT apart from the mark as shown. As of September 22, 2004, this registration was assigned to Fifth Third Bancorp, according to the Assignment Branch of the United States Patent and Trademark Office, at Reel 3312, Frame 0032.

⁸ Registration No. 2893156 issued to F.N.B. Corporation on October 12, 2004 claiming first use anywhere and first use in commerce at least as early as January 2003; no claim is made to the words WEALTH MANAGEMENT apart from the mark as shown. As of September 22, 2004, this registration was assigned to Fifth Third Bancorp, according to the Assignment Branch of the United States Patent and Trademark Office, at Reel 3312, Frame 0032.

WE HELP THOSE WHO'VE MADE IT
KEEP IT

for *inter alia* "Financial services, namely ... **financial planning services ... insurance underwriting in the field of life insurance, insurance brokerage services, investment brokerage services**" in International Class 36;⁹

BUSINESS ON THE GO CHECK CARD

for *inter alia* " ... mutual funds services ... financial planning ... investment services, namely investment brokerage ... mutual funds investment ... investment brokerage ... insurance services, namely insurance underwriting, brokerage and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services ... " in International Class 36;¹⁰

HAVE YOU MET LIFE TODAY?

for *inter alia* "**Insurance underwriting, agency, brokerage, and administration services for individual and group life, disability, long term care, property and casualty, and dental insurance, annuities, employee benefits, mutual funds, investment contracts, and retirement and savings plans; Financial analysis and consultation with respect to life and long term care insurance, annuities, retirement and savings plans, and securities; Investment advisory services; Investment management services ... Providing information in the fields of insurance, banking, investments, and financial services via the Internet; and a house mark for a full range of insurance, banking, investment. and financial**

⁹ Registration No. 2869436 issued to Curry Poole Group LLC on August 3, 2004, claiming first use anywhere at least as early as 2000 and first use in commerce at least as early as April 2003.

¹⁰ Registration No. 2832117 issued to F.N.B. Corporation on April 13, 2004, claiming first use anywhere and first use in commerce at least as early as April 10, 2003; no claim is made to the words CHECK CARD apart from the mark as shown. As of September 22, 2004, this registration was assigned to Fifth Third Bancorp, according to the Assignment Branch of the United States Patent and Trademark Office, at Reel 3312, Frame 0032.

BANKING THAT FITS YOUR LIFE



services" in International Class 36;¹¹

for inter alia " ... Insurance underwriting, agency, brokerage and administration services in the fields of individual and group life, disability, long term care, dental, property and casualty insurance and annuities ... investment, management, administration, distribution, agency, and brokerage of mutual funds, investment contracts and retirement plans; investment management services; estate trust management services; providing information in the fields of insurance and financial services via a global computer network" in International Class 36;¹²

for inter alia " ... insurance services, namely insurance underwriting, and extended warranty contracts in the fields of life, health, accident, fire, marine, medical, pre-paid health care, legal services ... investment consultation ... investment of funds, mutual funds, and real estate; investment brokerage ... mutual fund services; and all of the foregoing services also provided online via the global computer network" in International Class 36;¹³

¹¹ Registration No. 2687489 issued to Metropolitan Life Insurance Company on February 11, 2003 claiming first use anywhere at least as early as January 10, 2001 and first use in commerce at least as early as April 16, 2001.

¹² Registration No. 2681908 issued to Metropolitan Life Insurance Company on January 28, 2003 claiming first use anywhere and first use in commerce at least as early as March 2001.

¹³ Registration No. 2656599 issued to F.N.B. Corporation on December 3, 2002 claiming first use anywhere and first use in commerce at least as early as November 2, 2001; no claim is made to the words FIRST NATIONAL INVESTMENT SERVICES COMPANY apart from the mark as shown.



for inter alia " ... **mutual funds investment ... investment brokerage ... insurance services, namely insurance underwriting, brokerage and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services** ... and information services for all for the foregoing provided via a global computer network" in International Class 36;¹⁴



for inter alia " ... **mutual funds investment ... investment brokerage ... insurance services, namely insurance underwriting, brokerage and extended warranty contracts in the fields of life, health, accident, fire, marine, medical and pre-paid health care and legal services** ... and information services for all for the foregoing provided via a global computer network" in International Class 36;¹⁵

UG DIRECT

for inter alia "**Insurance underwriting services, namely, property and casualty, automobile, life, accident, health ...** management and **brokering of mutual funds** ... " in International Class 36;¹⁶

¹⁴ Registration No. 2704817 issued to F.N.B. Corporation on April 8, 2003, claiming first use anywhere and first use in commerce at least as early as February 18, 2002; no claim is made to the word INSURANCE apart from the mark as shown. As of September 22, 2004, this registration was assigned to Fifth Third Bancorp, according to the Assignment Branch of the United States Patent and Trademark Office, at Reel 3312, Frame 0032.

¹⁵ Registration No. 2797535 issued to F.N.B. Corporation on December 23, 2003, claiming first use anywhere and first use in commerce at least as early as July 15, 2002; Section 2(f) in part as to as to the words FIRST NATIONAL BANK OF PENNSYLVANIA; no claim is made to the words NATIONAL BANK apart from the mark as shown.

¹⁶ Registration No. 2776946 issued to United Guaranty Corporation, a North Carolina corporation, on October 21, 2003, claiming first use anywhere and first use in commerce at least as early as February 17, 2003; no claim is made to the word DIRECT apart from the mark as shown.

UNITED GUARANTY DIRECT

for "**Insurance underwriting services, namely, property and casualty, automobile, life, accident, health ... management and brokering of mutual funds ...**" in International Class 36;¹⁷

AMERICAN GENERAL

for *inter alia* "**insurance underwriting in the fields of life, accident, health, disability ... financial planning, namely, insurance planning, estate and retirement planning; executive retirement financial and investment consultation ... administration of mutual funds; investment counseling services; variable annuity underwriting services; mutual fund services, namely, mutual fund investment, mutual fund distribution and mutual fund brokerage; banking services**" in International Class 36;¹⁸

ROCHESTER FINANCIAL GROUP

for *inter alia* "**Insurance underwriting in the fields of individual life and group life insurance, disability, long term care, dental insurance, property and casualty insurance, annuities, mutual funds, employee benefits, investment contracts and retirement plans ... financial planning services ... estate trust management services ... providing information in the fields of insurance, banking and financial services ... addressing the needs of individuals and businesses**" in International Class 36;¹⁹

¹⁷ Registration No. 2750420 issued to United Guaranty Corporation, a North Carolina corporation, on August 12, 2003, claiming first use anywhere and first use in commerce at least as early as October 2002; no claim is made to the words GUARANTY DIRECT apart from the mark as shown.

¹⁸ Registration No. 2864984 issued to American International Group, Inc., a Delaware corporation, on July 20, 2004, claiming first use anywhere and first use in commerce at least as early as October 19, 1998.

¹⁹ Registration No. 2932090 issued on the Supplemental Register to Metropolitan Life Insurance Company, a New York corporation, on March 8, 2005, claiming first use anywhere and first use in commerce at least as early as January 2003; no claim is made to the word GROUP apart from the mark as shown.

These registrations are all based on use in commerce, and individually cover a number of different services. They support the Trademark Examining Attorney's position that these respective services have been registered by the same financial institutions under the same mark. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)

[Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"]. See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Accordingly, given the relationship of these respective services, this du Pont factor favors the position taken by the Trademark Examining Attorney.

Channels of Trade

As to the du Pont factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, it is clear from the third-party registrations that some of the same insurers and financial institutions apply the same mark to insurance brokerage services and insurance underwriting services, financial and retirement

planning services, investment counseling services, etc. Even if the services are not the same, it must be presumed that they move in all appropriate channels of trade and to all appropriate customers for those services as identified, and hence could be offered through the same channels of trade, and would be purchased by the same classes of consumers, i.e., relatively well-heeled consumers faced with an array of financial options. If these purchasers were to encounter the products under the same or similar marks, it would not be unreasonable for them to assume, mistakenly, that they originate from the same source. In re Elbaum, 211 USPQ 639 (TTAB 1981). Hence, this factor too favors the position taken by the Trademark Examining Attorney.

Conditions of Sale

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasers, applicant contends that inasmuch as its recitation of services specifies that this would be a "fee-based nondiscretionary mutual fund services for customers with a minimum account size of \$25,000," the targeted customers are by definition, sophisticated. Applicant argues that the purchase of the applicant's services is a sophisticated,

expensive purchase made by a highly discriminating purchaser.

Acknowledging the truth of applicant's contention that sophisticated purchasers are frequently involved in making the types of purchases that involve the services of applicant, the Trademark Examining Attorney noted that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or that they are immune from source confusion. Especially in a case such as this one where the marks are substantially identical, even a careful purchaser may well not be able to distinguish between applicant's and registrant's trademarks.

We concur that, even if the purchasers are sophisticated and the services expensive, this factor would not overcome the likelihood of confusion when the same mark is used on such closely-related services. See In re Hester Industries, Inc., 231 USPQ 881, 883 (TTAB 1986) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"]; and In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ["We recognize applicant's

attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion"]. Accordingly, under the circumstances, this du Pont factor cannot weigh in applicant's favor.

Conclusions

In conclusion, two key considerations support the conclusion that there is a likelihood of confusion herein, namely, applicant's mark is quite similar to registrant's mark and the respective services are deemed to be closely related.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.